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Enrique J. Mora, Esquire
Beusse, Brownlee, Bowdoin & Wolter, P.A.
390 North Orange Avenue, Suite 2500
Orlando, FL 32801

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OFFICE OF PETITIONS

In re Application of :
Schick et al. :
Application No. 09/736,495 : ON PETITION
Filed: December 13, 2000 :
Attorney Docket No. :
20-LC-2099/624226.289 :

This is a decision on the Re-Petition to Claim Benefit Under 35 U.S.C. [§] 120, 121 or 365(c) of a Prior Copending Nonprovisional Application or International Application Designating the United States of America, which is being treated as a renewed petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

This Petition is hereby **dismissed**.

Applicable Law

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition fails to satisfy item (1) above. In this regard, the amendment submitted with the petition references two of the prior-filed cases by the patent number rather than by the application number. Note 35 U.S.C. § 120, which provides, in relevant part:

No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. [Emphasis supplied.]

Note also CFR 1.78(a)(2)(i), which states, in relevant part:

Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications * * must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) * * * and indicating the relationship of the applications. [Emphasis supplied.]

Accordingly, a substitute amendment complying with 37 CFR 1.121 and satisfying the requirements of 37 CFR 1.78(a)(2)(i) must be submitted, along with a renewed petition under 37 CFR 1.78(a)(3).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiries concerning this decision may be directed to
Petitions Attorney Derek L. Woods at (571) 272-3232.


Frances Hicks
Petitions Examiner
Office of Petitions